

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Barry O'Brien et al.  
Patent No. : 7,488,343  
Issue Date : February 10, 2009  
Serial No. : 10/664,679  
Filed : September 16, 2003  
Title : MEDICAL DEVICES

Art Unit : 3734  
Examiner : Vi X Nguyen  
Conf. No. : 4092

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)**

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 762 to 1085 days, is respectfully requested.

**REMARKS**

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the

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failure of the United States Patent and Trademark Office to issue a patent within 3 years.”  
“B delay” begins only after the PTO has failed to issue a patent within three years, not before.  
Id.

#### REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

##### “A Delay”

A first PTO action was due on or before November 16, 2004 (the date that is fourteen months after September 16, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on December 12, 2006, thereby according a PTO Delay of 756 days. Patentee does not dispute the PTO's calculation for this “A Delay” from November 17, 2004 (the day after the date that is fourteen months after the date on which the application was filed), to December 12, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before June 11, 2008 (the date that is four months after February 11, 2008, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on June 18, 2008, thereby according a PTO Delay of 7 days. Patentee does not dispute the PTO's calculation for this “A Delay” from June 12, 2008 (the day after the date that is four months after the date on which a response to Office Action was filed), to June 18, 2008. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 763 days (i.e., the sum of 756 days and 7 days).

##### “B Delay”

The period beginning on September 17, 2006 (the day after the date that is three years after the date on which the application was filed), and ending February 10, 2009 (the date the patent was issued), is 878 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on October 31, 2007, and the patent issued on February 10, 2009, which resulted in a 468 day period that must also be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

"B Delay" for this patent is therefore calculated as 878 days minus 468 days, for a total of 410 days. The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 410 days.

#### Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

November 17, 2004, to December 12, 2006; and

June 12, 2008, to June 18, 2008.

As detailed above, "B Delay" accumulated during the following period:

September 17, 2006, to October 31, 2007.

As such, the periods of "A Delay" and "B Delay" overlap (i.e., occur on the same calendar day for a total of 87 days, from September 17, 2006, to December 12, 2006.

#### Applicant Delay

A reply to an Office Action was due on or before January 1, 2009 (the date that is three months after October 1, 2008, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on January 2, 2009, thereby according an Applicant Delay of 1 day. Patentee does not dispute the PTO's calculation for this Applicant Delay from January 2, 2009 (the day after the date that is three months after the date on which the Office Action was mailed), to January 2, 2009. See 37 C.F.R. § 1.704(b).

In view of the period of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 1 day.

Applicant : Barry O'Brien et al.  
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Page : 4 of 4

Attorney's Docket No.: 10527-0462001 / 02-253

### Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

### Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 762 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,086 days (i.e., the sum of 763 days of "A Delay" and 410 days of "B Delay" minus the 87 days of overlap);
- 2) Total Applicant Delay should be calculated as 1 day; and
- 3) Total PTA should be calculated as 1,085 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 10527-0462001.

Respectfully submitted,

Date: 4/9/09

  
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